

Application No.: 10/803,113
Docket No.: UC0223USCIP

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Remarks

Status of the Application

Claims 1-7 and 22 are pending. Applicants note that claim 22 was introduced in the RCE dated April 7, 2006, but has not been indicated as examined (or withdrawn) by the Examiner. Applicants respectfully request entry and examination of claim 22.

Statutory Double Patenting Not Established

Claims 1-6 were rejected over claims 1-5, 8, and 9 of co-pending application Serial No. 10/669,577. Applicants traverse the rejection as improper. The MPEP states:

"Same invention" means identical subject matter. [citations omitted] A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. [citation omitted] Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined by both claims and statutory double patenting would not exist.

MPEP 804.II.A.; emphasis added. Claim 1 of the '577 Application is broader than Claim 1 of the present application, which recites "fluorinated polymeric acid." Thus, an embodiment, namely "non-fluorinated polymeric acid," exists that could literally infringe Claim 1 of the '577 Application without literally infringing a corresponding claim in the present application. In addition, Claim 1 of the '577 Application recites a composition comprising an aqueous dispersion of "a polyaniline" and at least one colloid-forming polymeric acid as opposed to "at least one polyaniline" recited in Claim 1 of the present application. Thus, embodiments having more than one polyaniline could literally infringe claims of the present application without infringing a corresponding claim in the co-pending application. Claims 2-7 and 22 of this application are dependent (directly or indirectly) on Claim 1 and therefore incorporate both limitations of Claim 1 discussed above. Accordingly, the rejection was improper and should be withdrawn.

Prima Facie Obviousness Not Established

Claims 1-7 were rejected as obvious over U.S. Pat. No. 5,716,550 ("the Gardner reference"). Applicants traverse the rejection, and respectfully submit that no *prima facie* case of

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obviousness was established. Applicants apparently successfully rebutted the Office action's previous anticipation rejections that were based on many of the same column and line numbers as are now cited in the obviousness rejection (without analysis as to differences, motivations, or explanation). The MPEP requires that:

the examiner should set forth in the Office action:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,
- (B) the **difference or differences in the claim** over the applied reference(s),
- (C) the **proposed modification** of the applied reference(s) necessary to arrive at the claimed subject matter, and
- (D) an **explanation** why one of ordinary skill in the art at the time the invention was made would have been motivated to **make the proposed modification**.

MPEP 706.02(j); emphasis added.

The rejection is insufficient to meet the Examiner's *prima facie* burden of establishing obviousness. Merely citing column and page numbers, without analyzing the teachings, does nothing to demonstrate that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than not. MPEP 2142; *see also* MPEP 706.02(j) ("It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.").

Applicants face real-world consequences, including potential prosecution history estoppel, if they conjecture as to what the Examiner intended as the basis of rejection and then argue against this hypothetically proper rejection. It is also not the Applicants' burden. The Examiner is respectfully reminded that "[i]f the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." MPEP 2142.

Conclusion

The double patenting rejection should be removed and the obviousness rejection should be explained if it is to be reapplied to the pending claims. Applicants respectfully solicit a notice of allowance. Should the Examiner have questions, the Examiner is invited to call the undersigned at the telephone number listed below.

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Respectfully submitted,

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